

REMARKS

Applicants submit this Response in reply to the non-final Office Action mailed January 5, 2007. Claims 1-18 are pending in the application. For the reasons set forth below, Applicants believe that the rejections should be withdrawn and that the Claims 1-18 are in condition for allowance.

REJECTION OF CLAIMS 1-18 UNDER 35 U.S.C. § 103(a)

The Examiner rejected claims 1-18 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Publication No. 2001/0013009 to Greening *et al.* (“Greening”) in view of U.S. Patent No. 6,112,186 to Bergh *et al.* (“Bergh”). For at least the following reasons, the Applicants respectfully traverse this rejection and request reconsideration and withdrawal thereof. The Examiner has not established a prima facie case of obviousness. To establish a prima facie case of obviousness, the Examiner must: (1) identify the reason why a person of ordinary skill in the art would have combined the teachings of the references; and (2) show that the references teach or suggest all of the claimed limitations.

CLAIM 1

The Applicants respectfully submit that Greening and/or Bergh fail to disclose or suggest all of the limitations of the claims. The present invention as claimed produces a recommended item list from (1) the client identifier associated client preference estimating factor information and (2) the client preference estimating factor information. Regarding (2) the client preference estimating factor information, this information indicates a preference of a client without identifying that specific client (*e.g.*, no client identifier), and only this information (2) is received from the item provider server along with a recommended item presentation request (which also does not identify that client). In contrast, regarding (1) the client identifier associated client preference estimating factor information, this information identifies each client (*e.g.*, includes a client identifier or some other client identifying

information) and is obtained separately from a third party company or the like (*i.e.*, not from the item provider server).

In the present invention, (2) only indicates the preference of a client and does not contain any information to identify that client (*e.g.*, no client identifier), so from (2) it is impossible to identify that client. However, when used in conjunction with (1) (which is separately obtained), it becomes possible to identify other clients with similar preferences, such that it is possible to produce the recommended item list suitable for that client.

The item provider server is only required to send (2) for that client. The item provider server is not required to send (1) for that client (*i.e.*, no client identifier is sent by the item provider server). Therefore, the present invention does not require a client identifier from the item provider server to create the recommended item list suitable for that client. Hence, the internal client identifier used by the item provider server does not have to be unique and common to all servers. [0027, 0049].

Greening discloses a system that predicts the interest of a user in specific items, by directly using information which identifies each client and is directly obtained from each client, similar to (1) described above. Greening does not describe or suggest “receiving a recommended item presentation request and a client preference estimating factor information of one client from an item provider server”, since Greening describes obtaining a request from a client. Nor does Greening describe “providing items to a plurality of clients through a network, where the client preference estimating factor information indicates a preference of the one client, without identifying the one client”, since Greening describes information that identifies a specific client.

Furthermore, Greening does not describe or suggest producing the recommended item list from (1) and (2) (as described above), without requiring information to identify that client, as claimed in step (b) of Claim 1. The combined use of (1) and (2) is an essential feature of the present invention as claimed and Greening does not disclose or suggest the

claimed invention. None of the drawings or corresponding sections of the detailed description of Greening cited by the Examiner show otherwise.

The Examiner correctly notes that Greening does not disclose “without identifying the one client” as claimed in Claim 1. The Examiner contends that the concept is disclosed by Bergh in col. 31, line 65 to col. 32, line 20. However, the cited section of Bergh only discloses a scheme for using flags to enable or disable the transmission of data from a central server. For example, Bergh describes using a “0” to indicate that data should not be transmitted and a “1” to indicate that data should be transmitted. [31:48 - 32:2]. Bergh, further discloses that in using this convention, “it would inhibit the nodes from making recommendations to the user because the nodes would be unable to access the user’s preference data stored on the central server.” [32:2-8].

Therefore, Bergh does not disclose or suggest “receiving a recommended item presentation request and a client preference estimating factor information of one client from an item provider server for providing items to a plurality of clients through a network, where the client preference estimating factor information indicates a preference of the one client, without identifying the one client”, as recited in step (b) of Claim 1. Moreover, Bergh does not disclose or suggest producing the recommended item list from (1) and (2) (as described above), without requiring information to identify that client, as recited in step (b) of Claim 1. None of the drawings or corresponding sections of the detailed description of Bergh cited by the Examiner show otherwise.

Therefore, the Examiner has failed to show that Greening in combination with Bergh teaches or suggest all of the elements of Claim 1. The rejection is thus improper and should be withdrawn.

CLAIMS 9, 17, and 18

Claims 9, 17, and 18 recite similar elements to those recited by Claim 1. Accordingly, for at least the same reasons discussed above, Claims 9, 17, and 18 are patentable over Greening and Bergh.

CLAIMS 2 - 8 and 10 - 16

Claims 2 - 8 and 10 - 16 depend directly or indirectly from independent Claims 1 and 9. Accordingly, for at least the same reasons discussed above, Claims 2 - 8 and 10 - 16 are patentable over Greening and Bergh.

Furthermore, with regard to Claims 8 and 16. The Examiner contends that Bergh discloses features relevant to Claims 8 and 16 at Col. 10, lines 10-46. The cited section of Bergh merely describes a way of using item ratings and a threshold value. Bergh does not disclose or suggest any details of how to produce the recommended item list by the combined use of (1) and (2) (as described above), as recited in Claims 8 and 16. The rejection is thus improper and should be withdrawn.

Serial No. 10/053,788
Attorney Docket No. 44471/269115
Response to Office Action of January 5, 2007
Page 6 of 6

CONCLUSION

The foregoing is submitted as a complete response to the Office Action identified above. Applicants believe that all rejections are improper and should be withdrawn. This application should now be in condition for allowance, and the Applicants solicit a notice to that effect. If there are any issues that can be addressed via telephone, the Examiner is asked to contact the undersigned at 404.685.6799. The Commissioner is authorized to charge any additional fees that may be due or credit any overpayment to Deposit Account No. 11-0855.

Respectfully submitted,



By: Brenda O. Holmes
Reg. No. 40,339

KILPATRICK STOCKTON LLP
1100 Peachtree Street, Suite 2800
Atlanta, Georgia 30309-4530
Telephone: (404) 815-6500
Facsimile: (404) 815-6555
Docket No.: 44471/269115
Date: May 7, 2007